

## REMARKS

Claims 1-5 and 10-23 are pending. Claims 10-17 have been cancelled. Claims 1-5 and 18-20 stand amended. Claims 24-28 are added. No new matter is added. Claims 1-5 and 18-28 remain in the case for reconsideration.

Restriction Requirement

Responsive to a telephone conversation with the Examiner on March 28, 2005, Applicant hereby confirms electing claims 1-5 and 18-23, without traverse. Therefore, claims 10-17 have been cancelled without prejudice to pursue the subject matter thereof in a separate application.

Claim Rejections – 35 U.S.C. § 112

Claims 1-5 and 18-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The informalities cited by the Examiner have been corrected throughout the claims including amending the claims replace “body” with “sheet” as recommended by the Examiner.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 4 and 18 stand rejected under 35 USC 102(b) as being anticipated by Owens et al. The rejections are respectfully traversed.

With respect to amended independent claim 1, the claim is amended to clarify that the wall patch is comprised of a single sheet of material. The wall patch of claim 1 does not require the use of multiple layers of material.

Owens discloses a patch that “is made from a plate or sheet that is sandwiched between two thin sheets” of material. (see Col. 2, lines 1-2). Owens only discloses using three separate sheets of material to form the patch. Contrastingly, claim recites the use of only a single sheet of material.

Thus, Owens fails to disclose each and every element of amended independent claim 1. Therefore, claim 1 is believed to be allowable over Owens and allowance is respectfully requested.

Claim 4 depends from claim 1 and is also amended to clarify that the patch is comprised of a single sheet of tear-resistant material as opposed to the multiple layers of

material disclosed by Owens. Thus, Owens fails to disclose each and every element of claim 4. Therefore, claim 4 is believed to be allowable over Owens and allowance is respectfully requested.

With respect to amended independent claim 18, this claim is also amended to clarify that the wall patch comprises a single sheet. As explained above, Owens only discloses making a wall patch out of at least three sheets of material. Thus, Owens fails to disclose each and every element of claim 18.

Therefore, claim 18 is believed to be allowable over Owens and allowance is respectfully requested.

Claims 1, 4 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hoffmann, Sr. (6,231,949). The rejections are respectfully traversed.

With respect to amended independent claim 1, the single sheet of material includes a ready-to-paint upper surface. No other repair operations are required before painting the wall patch of claim 1 after application of the patch to the wall, because the single sheet of material already includes a ready-to-paint upper surface.

The wall patch disclosed by Hoffman requires the application of a curable repair compound 25 before paint can be applied to the patch 10. Hoffman describes the application at column 5, lines 50-55 with reference to FIG. 4 by stating:

Surface repair assembly 8 is applied to repair hole 30 in drywall section 27 by covering surface repair patch 10 with a thin layer of plaster of paris, gypsum material, spackling compound, spackle or other curable repair compound 25 which completes the assembly.

Hoffman notes later at Col. 6, lines 22-24, that the "repair compound 25 is then contoured with a flat-bladed tool so as to blend into the outside surface 28 of the drywall section 27."

These descriptions show that the wall patch in Hoffman is not ready-to-paint. Significant additional materials, work and tools are required before the Hoffman patch can be painted.

Thus, Hoffman fails to disclose each and every element of claim 1. Therefore, claim 1 is believed to be allowable over Hoffman and allowance is respectfully requested.

Claim 4 depends from claim 1, and for at least the same reasons given for claim 1, this claim is believed to be allowable over Hoffman and allowance is respectfully requested.

With respect to independent claim 18, this claim also recites that the wall patch has a ready-to-paint upper surface. As explained above, Hoffman does not disclose a wall patch

with a ready-to-paint upper surface. Thus, Hoffman fails to disclose each and every element of claim 18. Therefore, claim 18 is believed to be allowable over Hoffman and allowance is respectfully requested.

*Claim Rejections – 35 U.S.C. § 103*

Claims 2, 3, 5, and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Owens et al. or Hoffman, Sr., each taken individually, or alternatively, as evidence of the state of the art in view of Swallow for claims 2, 3, and 19, for claims 5 and 20 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada. The rejections are respectfully traversed.

With respect to claims 2 and 3, these claims depend from claim 1 and necessarily include all of the limitations of claim 1 including that the wall patch is comprised of a single sheet having a ready-to-paint upper surface.

As stated above, Owens discloses using multiple sheets to comprise a wall patch. The addition of Swallow does not cure this deficiency in Owens because Swallow also utilizes multiple sheets of material. Swallow in FIGS. 1, 4, 6 and 7 show the patch 10 comprising multiple layers of sheets of material including film 12 and adhesive bands 16 and 18.

As stated above, Hoffman does not disclose a wall patch with a ready-to-paint upper surface. The addition of Swallow to Hoffman does not cure this deficiency in Hoffman. FIG. 4 of Swallow shows the necessity of applying spackling 32 to the patch 10 to blend the patch 10 into the wall surface 30 (see Col. 6, lines 45-52).

Further, Owens cannot be combined with Hoffman to result in the patch recited in claim 1 of the present application because the wall patch of Hoffman would require the addition of another layer of material to include a ready-to-paint upper, thus becoming a multi-layer patch (such as in Owens) and not a patch comprising a single sheet of material.

Thus, neither the combination of Owens and Swallow, nor the combination of Hoffman and Swallow, (nor even the combination of Owens and Hoffman) disclose each and every element of amended independent claim 1. Therefore, these combinations also do not disclose each and every element of dependent claims 2 and 3.

Thus, claims 2 and 3 are believed to be allowable over the art of record and allowance is respectfully requested.

Claim 19 depends from amended independent claim 18 and necessarily includes all of the limitations of claim 18, including that the wall patch is comprised of a single sheet of material having a ready-to-paint upper surface. For at least the same reasons given above for

amended independent claim 1, the combinations of Owens and Swallow, Hoffman and Swallow, or even of Owens and Hoffman do not disclose each and every element of amended independent claim 18. Therefore, these combinations do not disclose each and every element of claim 19.

Thus claim 19 is believed to be allowable over the art of record and allowance is respectfully requested.

Claim 5 depends from amended independent claim 1 and claim 20 depends from amended independent claim 18. The addition of the FASSON trade publication does not cure the deficiencies of either Owens or Hoffman with respect to the independent claims. Thus, neither the combination of Owens with the FASSON trade publication nor the combination of Hoffman with the FASSON trade publication discloses each and every element of the independent claims 1 and 18. Thus, these combinations do not disclose each and every element of dependent claims 5 and 20.

Therefore, claims 5 and 20 are believed to be allowable over these combinations and allowance is respectfully requested.

Claims 21-23 depend from amended independent claim 18. The addition of Estrada does not cure the deficiencies of either Owens or Hoffman with respect to claim 18. Thus, neither the combination of Owens with Estrada nor the combination of Hoffman with Estrada discloses each and every element of independent claim 18. Thus, these combinations do not disclose each and every element of dependent claim 21-23.

Therefore, claims 21-23 are believed to be allowable over these combinations and allowance is respectfully requested.


Claims 24 and 25 add additional limitations not found in the prior art of record and are believed to be in condition for allowance.

**CONCLUSION**

For the foregoing reasons, reconsideration and allowance of claims 1-5 and 18-28 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, PC

  
James A. Hilsenteger  
Reg. No. 53,023

MARGER JOHNSON & McCOLLOM, PC  
210 SW Morrison Street, Suite 400  
Portland, Oregon 97204  
Telephone: 503-222-3613  
Customer No. 20575